



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,443	07/31/2001	Davin J. Fifield	5628.02	4657

20686 7590 04/07/2004

DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

EXAMINER


CAPUTO, LISA M

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/920,443	FIFIELD ET AL.	
	Examiner	Art Unit	
	Lisa M Caputo	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 8, 10 and 17 is/are rejected.
- 7) ☒ Claim(s) 3-6, 9, 11-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed 23 December 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 1-2 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla et al. (U.S. Patent No. 5,146,552, from hereinafter "Cassorla") in view of Cornelia et al. (U.S. Patent No. 6,065,026, from hereinafter "Cornelia").

Cassorla teaches a method for associating annotation with electronically published material. Cassorla discloses a method for transferring annotations associated with a draft electronic transcript having a word/line content to a revised

Art Unit: 2876

electronic transcript having a word/line content that comprises receiving both a draft electronic transcript and a revised electronic transcript and then annotating the revised electronic transcript based on the annotations on the associated with the draft electronic transcript and storing the revised electronic transcript and its created annotations. For example, Cassorla discloses that the user may then continue to add additional annotations to the paragraphs 40 or 42 or to add annotations to other paragraphs 43 in the formatted text stream 25. Any annotations, 28, for example, can be edited by the user or deleted by the user. An annotation string can also be a null character, so that the annotation can serve as a bookmark, for example. If the annotation served as a bookmark, then its type field would be changed to designate that function in the annotation string record of FIG. 3. Further, the user may elect to print the formatted text stream 25 and have the annotations 24' appear near their respective paragraph images 25'. This composite representation can be output on printer 44, by taking the composite image appearing on display 26 and performing a transfer of the contents of the display buffer associated with display 26, to the printer 44. This technique can also be used to transmit the composite image of annotation strings 24' and paragraphs 25' on the display 26 of FIG. 1, to the communications adapter 48 for transmission to other workstations or to a host computer connected thereto. Alternately, the formatted text stream 25 can be assembled as a first message and the annotation string records 24 can be assembled as a second message which can be transmitted either as a contiguous pair of messages or as separate messages over the communications

adapter 48 to other data processing units connected thereto (see Figures 1-6, col 5 line 55 to col 10 line 12, especially Figures 1 and 3 and col 6-7 and 9-10).

However, regarding claims 1-2 and 7-8, even though for the method of Cassorla to be run properly a determination must be made on whether the revision copy is derived from the draft copy, Cassorla fails to specifically teach that a determination is made from the word/line content of the revised electronic transcript and from the word/line content of the draft electronic transcript if the revised electronic transcript is derived from the draft electronic transcript.

Cornelia teaches a multi-user electronic document authoring system with prompted updating of shared language. Cornelia discloses that a determination is made regarding whether the word/line content of the revised electronic transcript is derived from the draft electronic transcript. For example, Cornelia teaches that a revision of the document is created, hence the document is definitively related. In addition, a compare button 158 provides a redline comparison between the revised component in the library and the existing component in the document. The comparison is performed in a new window in which added text is shown underlined and deleted text is shown struck out. An accept button 160 replaces the existing document component with the revised component from the library. If the author chooses to accept to a new component, the text of the component is inserted into the document. A reject button 162 leaves the existing document component unchanged. This should be used if the author does not wish to use the new language from the library (see Figure 27, col 13 line 40 to col 14 line 51).

In view of the teaching of Cornelia, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the determination if the revised electronic transcript is derived from the draft electronic transcript (using word/line content) because it is important that the documents are not misread or communicated to the wrong person. In addition, by using word/line content, a definitive answer is provided. Hence, it is favorable to be assured that the document being annotated is indeed the correct matching document.

4. Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla et al. (U.S. Patent No. 5,146,552, from hereinafter "Cassorla").

Regarding claims 10 and 17, Cassorla teaches a method for analyzing and indexing the structure of an electronic transcript comprising receiving electronic transcript data, dividing the transcript data into lexical units and transcript layout data, assigning properties to each line of the actual body text, and categorizing each line of the actual body text by assigning a structural description to each line (see Figures 1-6, col 5 line 50 to col 10 line 12).

Even though Cassorla does not use the phrases "structural description" in order to categorize the lines, this step is done via annotation of the document and its categorizations (i.e. the annotation strings such as "spelling?", "grammar?" etc.) are indeed structural descriptions of the document and how it is laid out and the properties can consist of variable components, such as words indicating proper grammar usage, upper case words, or words indicating a new speaker in a transcript.

Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the method of analyzing and indexing a transcript via annotations because it is a user friendly way to be able to discern what is disclosed within a document.

Allowable Subject Matter

5. Claims 3-6, 9, and 11-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The best prior art of record fails to teach the specific steps for determining the versions of the documents as outlined in claims 3-6, 9, and 11-16 (i.e. the forming of the different entries for the multiple word/line lists for each draft and revised copy that includes the hash symbol, page number, and line numbers and the use of repetitive linking steps).

Response to Arguments

7. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

8. Examiner appreciates applicant's arguments that the combination of Muranaga and Kish would not teach all of the limitations of the amended claims of the present invention and that the documents of Muranaga would be provided as an interconnection of a number of document-objects as opposed to a single document revision (if

Art Unit: 2876

combined with Kish) and has supplied new prior art in the form of Cassorla and Cornelia. See 35 U.S.C. 103 rejections above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 5,537,536 to Anderson et al. which discloses a method and apparatus for processing a display document utilizing a system level document framework.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are

Art Unit: 2876

unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lisa.caputo@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.



LMC

April 4, 2004



DIANE I. LEE
PRIMARY EXAMINER